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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/520,677

01/11/2005

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EXAMINER

WHITE, EVERETT NMN

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/520,677	<b>Applicant(s)</b> YAGINUMA ET AL.	
	<b>Examiner</b> EVERETT WHITE	<b>Art Unit</b> 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3, 16 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 16, 18-20, 22, 23 and 25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/21/2008</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. The amendment filed February 19, 2008 has been received, entered and carefully considered. The amendment affects the instant application accordingly:
  - (A) Claims 4-17 have been canceled;
  - (B) New Claims 18-25 have been added;
  - (C) Claim 1 has been amended;
  - (D) Comments regarding Office Action have been provided drawn to:
    - (I) 102(b) rejection, which has been maintained for the reasons of record;
    - (II) 103(a) rejection, which has been maintained for the reasons of record.
2. Claims 1-3, 16 and 18-25 are pending in the case.
3. The text of those sections of Title 35, U. S. Code not included in this action can be found in a prior Office action.

### ***Foreign Priority Claimed***

4. This application is a 371 of PCT/JP03/08793 International Filing Date: July 10, 2003 published in Japanese, which claims foreign priority to Japan 2002-204740 under 35 U.S.C. 119(a)-(d). It is noted that PCT/JP03/08793 and Japan 2002-204740 (July 12, 2002) are in Japanese, no translation into English.

### ***Election By Original Presentation***

5. Newly submitted Claims 21 and 24 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 21 and 24 being drawn to aqueous suspension-form composition are independent or distinct since the composition requires water as a component of the composition along with the cellulose product of the original claims. A rejection of the cellulose product of the originally claimed invention cannot be used to reject an aqueous composition of the cellulose product.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 21 and 24 are withdrawn from

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consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 18 and 20-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Applicant's amendment with respect to amended Claim 18 herein has been fully considered but is deemed to insert new matter into the claims since the specification as originally filed does not provide support for "a water-dispersible cellulose, the cellulose being derived from cell wall tissue of a plant excluding raw cotton, papilus grass, paper mulberry, paper bush, gampi, beet pulp, and fruit fiber pulp" which read literally on cellulose derived from the cited sources as not being available as water-dispersible cellulose. Most importantly, the original specification merely discloses the cited sources of cellulose "as usable, but sometimes not preferred". The phrase "usable, but sometimes not preferred" does not equal a teaching of being excluded as indicated in the instant claims. Newly added Claims 20-22 are rejected for the same reason since these claims are dependent from Claim 18.

Consequently, there is nothing within the instant specification which would lead the artisan in the field to believe that Applicant was in possession of the invention as it is now claimed. See *Vas-Cath Inc. v. Mahurkar*, 19 USPQ 2d 1111, CAFC 1991, see also *In re Winkhaus*, 188 USPQ 129, CCPA 1975.

***Claim Rejections - 35 USC § 102***

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8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 16, 18-20, 22, 23 and 25 stand rejected under 35 U.S.C. 102(b) as being anticipated by Dinand et al (US Patent No. 5,964,983) for the reasons disclosed on pages 2 and 3 of the Office Action filed November 19, 2007.

### ***Response to Arguments***

10. Applicant's arguments filed February 19, 2008 have been fully considered but they are not persuasive. Applicants amended the claims to recite that if the cellulose has a particular average degree of polymerization, then the  $\alpha$ -cellulose content of the cellulose would have a particular value. However, the Dinand et al patent discloses in Example 22 that the cellulosic residue thereof as having an average degree of viscosimetric polymerization of the order of 1,000, which is within the range of the 400 to 1300 degree of polymerization recited in instant Claim 1 and thus anticipate the degree of polymerization and  $\alpha$ -cellulose content of the cellulose recited in instant Claim 1 and newly cited Claims 19 and 23.

Applicants also argue that newly added Claims 18, 20 and 22 are drawn to a water-dispersible cellulose wherein the claims recite the cellulose as not being derived from specific sources. However, the Dinand et al patent does recites cellulose obtained from potato and carrot, which are not recited in said claims as a source excluded by the cellulose thereof.

Accordingly, the rejection of Claims 1-3, 16, 18-20, 22, 23 and 25 under 35 U.S.C. 102(b) as being anticipated by the Dinand et al patent is maintained for the reasons of record.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 1-3, 16, 18-20, 22, 23 and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dinand et al (US Patent No. 5,964,983) in view of Turbak et al (US Patent No. 4,483,743) for the reasons disclosed on pages 3-5 of the Office Action filed November 19, 2007.

13. Applicant's arguments filed February 19, 2008 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground that the microfibrillated cellulose of the Turbak et al patent may not be fine enough because of the lower pressure. This argument is not persuasive since the Dinand et al discloses subjecting the cellulose material thereof to pressures ranging from 20 MPa to 100 MPa, which covers part of the 60-414 MPa range recited in the instant specification. Accordingly, the rejection of Claims 1-3, 16, 18-20, 22, 23 and 25 under 35 U.S.C.

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103(a) as being unpatentable over the Dinand et al patent in view of Turbak et al patent is maintained for the reasons of record.

14. Claims 1-3, 16, 18-20, 22, 23 and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Dinand et al (US Patent No. 5,964,983) in view of Kajita et al (JP Pub. No. 58013713 A) for the reasons disclosed on pages 5 and 6 of the Office Action filed November 19, 2007.

15. Applicant's arguments filed February 19, 2008 have been fully considered but they are not persuasive. Applicants argue against the rejection on the ground that the loss tangent disclose in the Kajita et al publication has a different meaning from the loss tangent disclosed in the instant claims and Applicants also argue that the loss tangent of the Kajita et al publication are measured using a procedure that is different from the procedure recited in the instant application. Applicants are reminded that the Office is in no position to determine experimentally whether or not, in an invention such as that at issue, the subject matter is the same as that of the reference. Accordingly, in such instances, this shifts the burden to the Applicants who have the resources to make such a determination and is in a better position to determine experimentally the differences between the invention as claimed and that of the art. *In re Pye*, 355 F2d 641, 148 USPQ 426 (CCPA 1966).

### ***Summary***

16. Claims 1-3, 16, 18-20, 22, 23 and 25 are rejected; Claims 21 and 24 are withdrawn from consideration as being directed to non-elected inventions.

### ***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Examiner's Telephone Number, Fax Number, and Other Information***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is 571-272-0660. The examiner can normally be reached on 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Everett White/

Examiner, Art Unit 1623

/Shaojia Anna Jiang, Ph.D./

Supervisory Patent Examiner, Art Unit 1623